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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,596	01/30/2001	Mark R. Bennett	END9-2000-0188US1	2376
23550	7590	04/04/2006	EXAMINER	
HOFFMAN WARNICK & D'ALESSANDRO, LLC			SMITH, JEFFREY A	
75 STATE STREET			ART UNIT	
14TH FL			PAPER NUMBER	
ALBANY, NY 12207			3625	

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,596

Applicant(s)

BENNETT ET AL.

Examiner

Jeffrey A. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-12,14,16-23 and 25-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-12,14,16-23 and 25-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 April 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 29, 2005 has been entered.

Response to Amendment

The amendment filed December 29, 2005 has been entered and considered.

By this amendment:

claims 1, 2, 4-12, 14, 16-23, 25-31 are pending; and
claims 1, 11, 18, and 26 are currently amended.

Additionally:

claims 3, 13, 15, and 24 have been previously
cancelled.

An action on the merits follows.

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Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, 4-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

These claims set forth a system comprising a plurality of sub-systems. The recitation of each of these sub-systems is viewed as being directed to a program or its executable result, per se. Accordingly, the system, likewise, is viewed as a program or its executable result, per se. MPEP 2106.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claim 1, 2, 4-10, 18-23, and 25-31 rejected under 35 U.S.C. 103(a) as being unpatentable over Hamlin (U.S. Patent No. 6,310,888 B1) in view of Burks et al. (U.S. Patent No. 5,644,778).

Hamlin discloses a system and program product for exchanging information between at least two trading partners.

The system comprises a translation system for translating a transaction element sent from a first trading partner intended for a second trading partner specified by the first trading partner. The transaction element is translated from a first partner proprietary schema to a universal schema and from the universal schema to a second partner proprietary schema. Translation of the element comprises translating data content (col. 7, lines 1-33), a data format and an application format of the element (col. 1, lines 5-14; col. 2, line 59-col. 3, line 4).

The system further comprises a routing system (col. 3, lines 61-64) and a transaction management system for tracking the status of the transaction element ("receipt verification": col. 3, lines 5-15).

A mapping system includes a system for determining: a source of the transaction element, and application to which the

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transaction is regarding, and a recipient to which the transaction should be routed. See col. 4, lines 35-47.

A management system (104) is disclosed which controls data management, security, administration, and provides a partner directory.

Regarding designations related to the automotive industry and related partners: The Examiner notes that the mere designation of the system, partners, and data as being "automotive" in nature carries no structural implication and accordingly such designations do not move to otherwise structurally distinguish the instant invention from the structure of the system disclosed by Hamlin. These mere designations do not impact either the structure or operation of the Hamlin system.

Hamlin further teaches that the communication network 102 is preferably a computer network that supports the TCP/IP communication protocol. However, Hamlin also teaches that any suitable network or combination of networks may be used (col. 5, lines 52-55: emphasis added). This teaching suggests to the skilled artisan that a combination of different communication protocols would be present when implementation of the invention involves a combination of networks. Nonetheless, Hamlin fails to explicitly teach a routing system for routing the transaction

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element from the first trading partner in a first communication protocol to the second trading partner in a second different communication protocol of the second trading partner.

Now comes Burks et al.

Burks et al. discloses a similar system for exchanging information between at least two trading partners engaged in a transaction (col. 3, lines 2-25). Burks et al. teaches a routing system for routing a transaction element from a first trading partner in a first communication protocol to a second trading partner in a second different communication protocol of the second trading partner (col. 5, lines 42-60; col. 7, lines 46-59).

It would have been obvious to one of ordinary skill in the art to have provided the system of Hamlin to have included a routing system for routing a transaction element from a first trading partner in a first communication protocol to a second trading partner in a second different communication protocol of the second trading partner as taught by Burkes et al in order that trading partners may communicate data to a wide variety of other trading partners using the system without the need to modify its existing communication protocols and without impacting existing communication protocol agreements with other trading partners (col. 3, lines 38-51).

Claims 11, 14, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamlin (U.S. Patent No. 6,310,888 B1) in view of "EDI-the grand daddy of electronic commerce", BT Technol J, Vol. 17, No. 3, July 1999, pp. 17-23 (hereafter "EDI") and Burks et al. (U.S. Patent No. 5,644,778).

Hamlin does not disclose a method for exchanging automotive information. Hamlin, rather, discloses, more generically, a method for exchanging information between processing systems such as an inventory management system, a financial processing system, a shipping control system, point of sale equipment, bar code scanning systems, or a warehouse management system.

EDI teaches that process driven industries such as retail distribution, automotive manufacture, and international logistics are sub areas of "supply chain driven trading".

It would have been obvious to one of ordinary skill in the art to have provided a method for exchanging automotive information between at least two automotive industry trading partners (similar to supply chain driven trading between partners in the automotive manufacturing area taught by EDI) as a more specific application of the generic method of exchanging information between processing systems such as the inventory management system, the financial processing system, the shipping

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control system, the point of sale equipment, the bar code scanning systems, or the warehouse management system already taught by Hamlin (col. 5, 55-67).

Hamlin further teaches that the communication network 102 is preferably a computer network that supports the TCP/IP communication protocol. However, Hamlin also teaches that any suitable network or combination of networks may be used (col. 5, lines 52-55: emphasis added). This teaching suggests to the skilled artisan that a combination of different communication protocols would be present when implementation of the invention involves a combination of networks. Nonetheless, the combination of Hamlin and EDI does not provide a step of routing the transaction element from the first trading partner in a first communication protocol to the second automotive trading partner in a second different communication protocol.

Now comes Burks et al.

Burks et al. discloses a similar method for exchanging information between at least two trading partners engaged in a transaction (col. 3, lines 2-25). Burks et al. teaches a routing a transaction element from a first trading partner in a first communication protocol to a second trading partner in a second different communication protocol of the second trading partner (col. 5, lines 42-60; col. 7, lines 46-59).

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It would have been obvious to one of ordinary skill in the art to have provided the combined method of Hamlin and EDI to have included a step of routing a transaction element from a first trading partner in a first communication protocol to a second trading partner in a second different communication protocol of the second trading partner as taught by Burkes et al in order that trading partners may communicate data to a wide variety of other trading partners using the system without the need to modify its existing communication protocols and without impacting existing communication protocol agreements with other trading partners (col. 3, lines 38-51).

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bennett et al. (U.S. Patent No. 6,092,121) discloses a method and apparatus for electronically integrating data captured in heterogeneous information systems of trading

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partners of an automotive dealer (col. 3, lines 27-45). This patent has a common assignee and no common inventors.

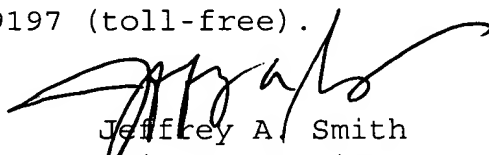
Hellbusch et al. (U.S. Patent No. 6,647,420 B2) discloses a federated business system that interconnects applications of multiple companies of the automotive retail industry (col. 10, lines 26-29).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is (571) 272-6763. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert M. Pond can be reached on 571-272-6760. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey A. Smith
Primary Examiner
Art Unit 3625

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